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EXAMINER

QM32/0405

HOWARD N FLAXMAN
AQUILINO & WELSH
2341 JEFFERSON DAVIS HWY STE 112
ARLINGTON VA 22202

BLAU S

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/173,445
Filing Date: 10/16/98
Appellant(s): Benjamin J. Kwitek

Howard N. Flaxman
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 15 February 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3, 7-10, and 21-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) *Claims Appealed*

Claim 14 contain(s) substantial errors as presented in the Appendix to the brief.

Accordingly, claim 14 correctly written in the Appendix to the examiner's answer.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|-----------|--------|--------|
| 5,322,290 | MINAMI | 6-1994 |
| 5,555,584 | MOORE | 9-1996 |
| 5,730,669 | HUANG | 3-1998 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1, 3, 7-10 and 14 are rejected and claims 21 -29 are rejected under 35

U.S.C. 103(a) as being unpatentable over Minami in view of Huang (5,730,669) and Moore.

Minami discloses a tubular shell (5), a viscoelastic hand surface about the outer surface of the tubular shell having a thickness, a central section (Ref. no. 6, Col. 3 Lns. 2-4, Col. 3 Lns. 14-16, Fig. 3), a tubular shell being a soft elastomer in form of being made of rubber and being softer than the hand surface (Col. 3 Lns. 51-53), a golf club grip (Fig. 1), and a shell being substantially cylindrical shaped with a slight taper (Figs. 2-3). Minami does not disclose a specific thickness for a viscoelastic hand surface but clearly one skilled in the art of forming a grip with enough vibration absorption material would have selected a suitable thickness for a viscoelastic hand surface in which a thickness between 1/16 and 1/4 inch is included.

Minami lacks a viscoelastic hand surface being a viscous silicone gel contained within an elastomeric bag and a tubular shell having circumferential lips to contain the viscoelastic hand surface, a central section having a depth as defined by the first and second lips which is substantially the same as the thickness of a viscoelastic hand surface, and a viscoelastic hand surface having a thickness between approximately 1/16 inch and 1/4 inch. Huang discloses a shell having circumferential lips and a central section having a depth as defined by the first and second lips which is substantially the same as the thickness of a viscoelastic hand surface (Figs. 11 and 13). In view of the patent of Huang it would have been obvious to modify the grip of Minami to have lips on a tubular shell as defined by the claims in order to better secure a hand surface about

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a tubular shell and to make the grip visually pleasing to a user by having the outer diameter the same size between the tubular shell and the viscoelastic hand surface.

Moore discloses a viscoelastic hand surface being a viscous silicone gel (Col. 5 Lns. 32-67) material contained within an elastomeric bag for a tennis racket in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player (Col. 1, Lns. 19-27) and sheets of gel material of about 1/8 to 1/4 inch (Col. 10, Lns. 55-64). In view of the patent of Moore it would have been obvious to modify the grip of Minami to have a viscoelastic hand surface as defined by the claims in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player. In addition, it would have been obvious to modify the grip of Moore to have a viscoelastic hand surface having a thickness between 1/8 and 1/4 inch in order to provide enough material to absorb vibrations without adding excessive weight.

Response to Arguments

3. The argument that it is improper to combine the references of Moore and Huang with Minami since Huang makes no suggestion as to the depth and of the guide cylinder and Huang makes no provisions for utilizing lips for retaining viscoelastic material between is disagreed with. Huang clearly shows the teaching of retaining an outer layer for a grip in figures 12 and 13. This teaching can be utilized for any type of outer layer. Moore provides a suitable outer layer. The

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argument that it is improper to combine the references of Moore and Minami since there is no suggestion to do so is disagreed with. Minami provides a general teaching of using a two layer grip with the outer layer being of high viscosity. Minami is quite to the specific types of high viscosity materials. Clearly this is a suggestion that suitable high viscosity materials can be substituted. Moore provides a suitable high viscosity material. The argument that nothing in the prior art suggests a range of thickness as defined by the claims is disagreed with. Moore clearly discloses a thickness for sheets of this material in the ranges as claimed. Golfers have all sorts of needs from minimizing weight of a grip in order to lower a swing weight of a club to maximizing grip material to minimizing damage to a players hand when impacting a ball. These ranges are a suitable range that can be selected by a golfer.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(11) *Response to Argument*

In the arguments filed 15 February 2001, the appellant argues:

1. It is improper to combine the references of Huang with Moore since Huang makes no provision for utilizing upper and lower lips as a mechanism for retaining a viscoelastic material therebetween and any consideration of depth is irrelevant.

2. It is improper to combine the references of Huang and Moore since Moore provides no suggestion for retaining the disclosed grip surface between upper and lower lips.

3. It is improper to combine the references since the grips disclosed in the cited prior art consider very different problems and the teachings are not appropriate for modifying the other cited patents. The references have no bearing because none of these references provide teachings which are relevant to the other prior art references.

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4. Moore discloses no need for retaining the viscoelastic hand surface on the grip he discloses.

5. Huang discloses no reason for including lips of a specific depth to retain a gripping surface therebetween.

6. With respect to item 1, the argument that it is improper to combine the references of Huang with Moore since Huang makes no provision for utilizing upper and lower lips as a mechanism for retaining a viscoelastic material therebetween and any consideration of depth is irrelevant is disagreed with. Huang clearly discloses a structure of retaining an outer layer of a grip. This structure can be used for a number of different types of outer layers including liquid viscoelastic materials. It seems unreasonable to conclude that using lips on each different type of outer layer for a grip is considered novel and warrants a patent. Huang teaches using lips to retain outer layers and now this teaching is available to one skilled in the art to utilize for a variety of different outer layer materials. In addition Huang discloses an outer layer having pores (Fig. 10, reference number 30) and due to the lack of a discussion of what is in the pores, it is most likely air in these pores which is a viscous material. So a suitable selection of what is contained in the pores would result in similar grip materials between Huang and Moore (i.e. viscous material). In addition, figure 13 discloses lips having

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a depth which is sufficient to retain an outer layer of a grip. This teaching in figure 13 can be used to take into account the selection of different but suitable materials.

7. With respect to item 2, the argument that is improper to combine the references of Huang and Moore since Moore provides no suggestion for retaining the disclosed grip surface between upper and lower lips is disagreed with. It is agreed with the Moore does not provide a suggestion of using lips but the examiner takes the position that with the teaching of Huang and Minami there is motivation to have a tubular shell and lips as defined by the claims. The motivation to have a tubular shell is found in Minami which is to have a grip with an enhanced sense of fitness and firmness (Minami, Col. 1, Lns. 55 through Col. 2, Lns. 7). The motivation to have lips shown in Huang (figure 13) and provided by the examiner which is to better secure a hand surface about a tubular shell.

8. With respect to item 3, the arguments that it is improper to combine the references since the grips disclosed in the cited prior art consider very different problems and the teachings are not appropriate for modifying the other cited patents and the references have no bearing because none of these references provide teachings which are relevant to the other prior art references is disagreed with. Minami discloses a general teaching of combining different materials to form a grip. The outer layer is a high viscosity material. Minami is quiet to the specific type of high viscosity material. Moore is very relevant to the patent of

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Minami since it discloses a specific type of high viscosity material which is known and used in the art. In addition, Minami discloses a structure of combining a hand surface with a tubular shell. There are other relevant structures which can be used to combine hand surfaces with tubular shells which have additional advantages and the teaching of Huang was used to show another relevant way which has an advantage which the patent of Minami doesn't. And that is to better retain an outer layer over an inner layer.

9. With respect to item 4, the argument that is improper to combine the references of Moore and Huang since Moore discloses no need for retaining the viscoelastic hand surface on the grip he discloses is disagreed with. It is agreed that Moore does not make this suggestion but the examiner believes there is motivation. See paragraph 7 above.

10. With respect to item 5, the argument that is improper to use the reference of Huang since Huang discloses no reason for including lips of a specific depth to retain a gripping surface therebetween as defined by the claims is disagreed with. See paragraph 6 above.

11. In closing, the following is reiterated. Huang clearly discloses a structure of retaining an outer layer of a grip. This structure can be used for a number of different types of outer layers including liquid viscoelastic materials. It seems unreasonable to conclude that

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using lips on each different type of outer layer for a grip is considered novel and warrants a patent. Huang teaches using lips to retain outer layers and now this teaching is available to one skilled in the art to utilize for a variety of different outer layer materials.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted, Stephen Blau



conferee



Mark Graham




Steve Wong

slb

April 4, 2001

HOWARD N FLAXMAN
AQUILINO & WELSH
2341 JEFFERSON DAVIS HWY STE 112
ARLINGTON VA 22202



JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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APPENDIX

14. A grip according to claim 9, wherein the tubular shell is a soft elastomer.